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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/033,168	DUELL ET AL.
	Examiner Timothy M. Harbeck	Art Unit 3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 18 October 2001.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-38 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-38 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>08/05/2002</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Double Patenting

Claims 11-13 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 3-5. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-10 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are directed toward a system and a computer, however the bodies of the claim do not recite any structure. Therefore the claims are indefinite because it is unclear what the system is comprised of.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-10, 20, 21-25 and 34-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Software, programming, instructions or code not claimed as encoded on computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

Claims 8-10, 20, 21-25 and 34-38 are therefore rejected where there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a computer. Examiner suggests that the applicant incorporate into Claims 8-10, 20, 21-25 and 34-38 language that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

Correction required. See MPEP § 2106 [R-2].

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3-4, 7, 11-12, 14, 26, 28, 32 and 34 are rejected under 35 U.S.C. 102(e)

as being anticipated by Carlton-Foss (US 6,647,373 B1).

Re Claim 3: Carlton-Foss discloses a computer network connecting an electronic auction metrics computer and one or more electronic auction computers, wherein the electronic auction metrics computer is coupled to one or more user computers over a computer network, a method comprising:

- Receiving electronic auction information at the electronic auction metrics computer from one or more electronic auction computers (Column 3, lines 38-50);
- Storing the electronic auction information in a metrics database (Column 3, lines 50-57)
- Receiving a request from a user computer for a specified metrics report (Column 3, lines 61-67)

- Searching the metrics database for metrics data, wherein the metrics data is based on electronic auction information (Column 5 line 63-Column 6 line 9)
- Creating a metrics report based on the request from the user (Column 6, lines 10-26)
- Providing the metrics report to the user (Column 6, lines 10-13)

Re Claim 4: Carlton Foss discloses the claimed method supra and further discloses requesting electronic auction information from one or more electronic auction computers (Column 3, lines 38-67)

Re Claim 7: Carlton-Foss discloses the claimed method supra and further discloses wherein the electronic metrics computer is the same as the one or more electronic auction computers (Column 5, lines 55-59)

Re Claim 11: Carlton-Foss discloses a computer network connecting an electronic auction metrics computer and one or more electronic auction computers, wherein the electronic auction metrics computer is coupled to one or more user computers over a computer network, a method comprising:

- Receiving electronic auction information at the electronic auction metrics computer from one or more electronic auction computers (Column 3, lines 38-50);
- Storing the electronic auction information in a metrics database (Column 3, lines 50-57)

- Receiving a request from a user computer for a specified metrics report (Column 3, lines 61-67)
- Searching the metrics database for metrics data, wherein the metrics data is based on electronic auction information (Column 5 line 63-Column 6 line 9)
- Creating a metrics report based on the request from the user (Column 6, lines 10-26)
- Transmitting the metrics report to the user (Column 6, lines 10-13)

Re Claim 12: Carlton Foss discloses the claimed method supra and further discloses requesting electronic auction information from one or more electronic auction computers (Column 3, lines 38-67)

Re Claim 14: Carlton Foss discloses the claimed method supra and further discloses wherein the user request includes the desired subject matter of the report (Fig 15; Status, date, specification).

Re Claim 26: Carlton-Foss discloses a computer network connecting an electronic auction metrics computer and one or more electronic auction computers, wherein the electronic auction metrics computer is coupled to one or more user computers over a computer network, a method comprising:

- At a user computer, receiving from a user a request for a metrics report based on electronic auction information (Column 3, lines 38-50);
- At a user computer, sending to an electronic auction metrics computer a request for a metrics report, wherein the request includes information

identifying the type of metrics report desired; (Column 3, lines 58-67
"selected information from the request database)

- At a user computer, receiving from the electronic auction metrics computer an indication of the metrics report (Column 3, lines 50-67)
- At a user computer, displaying to the user the metrics report (Column 3, lines 61-64)

Re Claim 28: Carlton-Foss discloses the claimed method supra and further discloses wherein the electronic auction metrics computer, upon receiving the request that the user desires a metrics report, searches a metrics database and creates a metrics report based on the electronic auction information (Column 3, lines 57-67)

Re Claim 32: Carlton-Foss discloses the claimed method supra and further discloses wherein the type of metrics report specified by the user is a standard metrics report (Column 3, lines 61-67).

Re Claim 34: Carlton-Foss discloses a computer readable medium containing a data structure for use by an electronic auction metrics system, the data comprising:

- Metrics auction information, wherein the metrics auction information includes
 - An auction number
 - A commodity
 - A business
 - An auction value
 - A date

- o A description of the product procured and
- o An identification of a person responsible for the electronic auction

(Column 3, lines 42-57)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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Claims 1-2, 5-6, 8-10, 13, 15-25, 27, 29-31, and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlton-Foss.

Re Claim 1: Carlton-Foss discloses a computer network connecting an electronic auction metrics computer and one or more electronic auction computers, wherein the electronic auction metrics computer is coupled to one or more user computers over a computer network, a method comprising:

- Receiving electronic auction information at the electronic auction metrics computer from one or more electronic auction computers, wherein the electronic auction information includes information about the results and performance of an electronic auction (Column 3, lines 38-50);
- Storing the electronic auction information in a metrics database, wherein the metrics database is coupled with the electronic auction metrics computer via a computer network (Column 3, lines 50-57)

- Receiving a request from a user computer for a specified metrics report, wherein the user specifies details about the report including subject matter of the report (Column 3, lines 61-67)
- Transmitting a request to the metrics database for metrics data, wherein the metrics data that is requested is based on the report request from the user (Column 5, lines 63-66)
- Receiving the metrics data from the metrics database (Column 6, lines 10-17) including subject matter of the report and timeframe of the report (Fig 15; Status, date, specification)
- Creating a metrics report based on the request from the user computer, wherein the data is used to create a metrics report is the metrics data received from the metrics database (Column 6, lines 10-26)
- Providing the metrics report to the user via a delivery method (Column 6, lines 10-13)

Carlton-Foss does not explicitly disclose wherein the user specifies the report delivery method and wherein the report is delivered via the method specified by the user. However these steps were old and well known in the art at the time of invention as a means to provide even further service to the customers of electronic auctions. Some customers prefer that a report be emailed to them, while some are comfortable with a summary on a particular webpage. Still others might prefer a detailed hard copy report. Therefor it would have been obvious to one of ordinary skill in the art to allow the customer to specify the delivery method of the report, so that the individual

customer can receive the report in a medium that is acceptable to their comforts and standards.

Re Claim 2: Carlton Foss discloses the claimed method supra and further discloses wherein:

- The computer network is the World Wide Web (Fig 2, Ref 56)
- Wherein the electronic auction information includes a business a commodity, an auction value and a date of completion (Fig 15 and Column 3 lines 47-57) and
- Further comprising processing the electronic database auction information before the electronic auction information is stored in the metrics database (Column 3, lines 14-37)

Carlton-Foss does not explicitly disclose wherein receiving electronic auction information occurs automatically at pre-determined intervals. However Carlton-Foss does note that requesters may witness the bidding and alter the environment of that bidding before and during the time of the competitive bidding process. Further it was well known in the art at the time of invention to receive reports at predetermined intervals. This allows the requesters to consistently and constantly track the progress of the auction and make appropriate adjustments. It would have been obvious to one of ordinary skill in the art at the time of invention to include this step so that the requestors do not have to waste time and effort it constantly request a report and can simply receive them at different intervals. This allows for faster and more accurate adjustments to be made to the bidding environment.

Re Claim 5: Carlton-Foss discloses the claimed method *supra* but does not explicitly disclose transmitting electronic auction information to the electronic auction metrics computer automatically at predetermined intervals from one or more electronic auction computers. However it was well known in the art at the time of invention to transmit information to a metrics computer at periodic intervals so that the metrics information can be constantly monitored and updated. If this were not done, the information in the database would be old and therefore provide the user with erroneous data. It would have been obvious to one of ordinary skill in the art at the time of invention to include this step to the disclosure of Carlton-Foss so that the information provided by the metrics computer is accurate and up to date and the users can make adjustments based on data that is current and useful.

Re Claim 6: Carlton Foss discloses the claimed method *supra* and further discloses wherein the user request includes details about the requested report including the subject matter of the report and timeframe of the report (Fig 15; Status, date, specification). Carlton-Foss does not explicitly disclose wherein the user specifies the report delivery method. However this step was old and well known in the art at the time of invention as a means to provide even further service to the customers of electronic auctions. Some customers prefer that a report be emailed to them, while some are comfortable with a summary on a particular webpage. Still others might prefer a detailed hard copy report. Therefor it would have been obvious to one of ordinary skill in the art to allow the customer to specify the delivery method of the report, so that the

individual customer can receive the report in a medium that is acceptable to their comforts and standards.

Re Claim 8: Further system claim would have been obvious to perform from previously rejected method claim 3, and is therefore rejected using the same art and rationale.

Re Claims 9 and 10: Further system claims would have been obvious to perform from previously rejected method claims 1 and 7, and are therefore rejected using the same art and rationale.

Re Claim 13: Carlton-Foss discloses the claimed method *supra* but does not explicitly disclose transmitting electronic auction information to the electronic auction metrics computer automatically at predetermined intervals from one or more electronic auction computers. However it was well known in the art at the time of invention to transmit information to a metrics computer at periodic intervals so that the metrics information can be constantly monitored and updated. If this were not done, the information in the database would be old and therefore provide the user with erroneous data. It would have been obvious to one of ordinary skill in the art at the time of invention to include this step to the disclosure of Carlton-Foss so that the information provided by the metrics computer is accurate and up to date and the users can make adjustments based on data that is current and useful.

Re Claim 15: Carlton-Foss discloses the claimed method *supra* but does not explicitly disclose wherein the user specifies the report delivery method. However this step was old and well known in the art at the time of invention as a means to provide

even further service to the customers of electronic auctions. Some customers prefer that a report be emailed to them, while some are comfortable with a summary on a particular webpage. Still others might prefer a detailed hard copy report. Therefor it would have been obvious to one of ordinary skill in the art to allow the customer to specify the delivery method of the report, so that the individual customer can receive the report in a medium that is acceptable to their comforts and standards.

Re Claim 16: Carlton-Foss discloses the claimed method *supra* but does not explicitly disclose wherein the user request includes a start time and an end time for the metrics data used to create the metrics report. However this step is old and well known in the art at the time of invention as a way to provide information relative to a particular time period. For example a user may be interested in the auction information, such as the number of bids, during the first few days of the auction versus the last few days in. This allows the user to see which time periods are the most active in terms of bidding. It would have been obvious to one of ordinary skill in the art at the time of invention to include this step to the disclosure of Carlton-Foss so that a user can evaluate an auction during a particular relative time period so that further adjustments can be made prior to completion or in future auctions with similar attributes.

Re Claim 17: Carlton-Foss discloses the claimed method *supra* but does not explicitly disclose wherein the metrics report includes electronic auctions performed only for a certain business. However it was old and well known in the art for a business to participate in a number of separate auctions using the same system. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to include

this step to Carlton-Foss so that a particular business can view each and every auction in which they are a part of in order to further evaluate their overall efficiency across the entire business and see which types of auctions and products are succeeding and which need to become more efficient.

Re Claim 18: Carlton-Foss discloses the claimed method *supra* but does not explicitly disclose wherein the metrics report includes electronic auctions performed to acquire a particular commodity. However it was old and well known in the art for there to be multiple auction involving the same commodity. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to include this step to Carlton-Foss in order to view the efficiency of one particular auction relative to the overall marketplace of that particular commodity. In this manner appropriate adjustments can be made in the particular auction was underperforming relative to the overall market.

Re Claim 19: Carlton-Foss discloses the claimed method *supra* but does not explicitly disclose calculating the savings achieved through the use of electronic auctions, wherein the savings is based on a pre-auction value and a post-auction value, and wherein further the created metrics report includes the savings achieved for each electronic auction. However, Carlton-Foss does disclose the importance of cost in evaluating an electronic auction (Column 10 line 66-Column 12 line 60) and furthermore it was well known in the art for an entity to be concerned with the cost of operations for their particular business. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to include this step to the disclosure of Carlton-Foss so

that each entity can evaluate the overall cost of the electronic auctions, as well as the savings provided in order to make future business decisions. If there were significant savings the business would continue to utilize the auction system. On the contrary if the cost is too high the business might reevaluate. Cost is a central tenet to any business and providing this information would be very useful and advantageous.

Re Claims 20 and 21: Further electronic auction computer and computer readable medium claims would have been obvious in order to implement the previously rejected method claim 3 and are therefore rejected using the same art and rationale.

Re Claim 22: Carlton-Foss discloses the claimed computer readable medium claim supra and further discloses storing the electronic auction information in a database (Fig 5, Ref 119).

Re Claim 23: Carlton-Foss discloses the claimed computer readable medium claim supra and further discloses requesting electronic auction information from one or more electronic auction computers (Column 3, lines 38-67)

Re Claim 24: Carlton-Foss discloses the claimed computer readable medium supra but does not explicitly disclose transmitting electronic auction information to the electronic auction metrics computer automatically at predetermined intervals from one or more electronic auction computers. However it was well known in the art at the time of invention to transmit information to a metrics computer at periodic intervals so that the metrics information can be constantly monitored and updated. If this were not done, the information in the database would be old and therefore provide the user with erroneous data. It would have been obvious to one of ordinary skill in the art at the time

of invention to include this step to the disclosure of Carlton-Foss so that the information provided by the metrics computer is accurate and up to date and the users can make adjustments based on data that is current and useful.

Re Claim 25: Carlton-Foss discloses the claimed computer readable medium supra but does not explicitly disclose calculating the savings achieved through the use of electronic auctions, wherein the savings is based on a pre-auction value and a post-auction value, and wherein further the created metrics report includes the savings achieved for each electronic auction. However, Carlton-Foss does disclose the importance of cost in evaluating an electronic auction (Column 10 line 66-Column 12 line 60) and furthermore it was well known in the art for an entity to be concerned with the cost of operations for their particular business. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to include this step to the disclosure of Carlton-Foss so that each entity can evaluate the overall cost of the electronic auctions, as well as the savings provided in order to make future business decisions. If there were significant savings the business would continue to utilize the auction system. On the contrary if the cost is too high the business might reevaluate. Cost is a central tenet to any business and providing this information would be very useful and advantageous.

Re Claim 27: Carlton-Foss discloses the claimed method supra but does not explicitly disclose wherein the user request includes the report delivery method for the report. However this step was old and well known in the art at the time of invention as a means to provide even further service to the customers of electronic auctions. Some

customers prefer that a report be emailed to them, while some are comfortable with a summary on a particular webpage. Still others might prefer a detailed hard copy report. Therefor it would have been obvious to one of ordinary skill in the art to allow the customer to specify the delivery method of the report, so that the individual customer can receive the report in a medium that is acceptable to their comforts and standards.

Re Claim 29: Carlton-Foss discloses the claimed method *supra* but does not explicitly disclose wherein the user request includes a start time and an end time for the metrics data used to create the metrics report. However this step is old and well known in the art at the time of invention as a way to provide information relative to a particular time period. For example a user may be interested in the auction information, such as the number of bids, during the first few days of the auction versus the last few days in. This allows the user to see which time periods are the most active in terms of bidding. It would have been obvious to one of ordinary skill in the art at the time of invention to include this step to the disclosure of Carlton-Foss so that a user can evaluate an auction during a particular relative time period so that further adjustments can be made prior to completion or in future auctions with similar attributes.

Re Claim 30: Carlton-Foss discloses the claimed method *supra* but does not explicitly disclose wherein the user request includes a business. However it was old and well known in the art for a business to participate in a number of separate auctions using the same system. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to include this step to Carlton-Foss so that a particular business can view each and every auction in which they are a part of in order to further

evaluate their overall efficiency across the entire business and see which types of auctions and products are succeeding and which need to become more efficient.

Re Claim 31: Carlton-Foss discloses the claimed method supra but does not explicitly disclose wherein the user request includes a commodity. However it was old and well known in the art for there to be multiple auction involving the same commodity. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to include this step to Carlton-Foss in order to view the efficiency of one particular auction relative to the overall marketplace of that particular commodity. In this manner appropriate adjustments can be made in the particular auction was underperforming relative to the overall market.

Re Claim 33: Carlton-Foss discloses the claimed method supra but does not explicitly disclose wherein the type of metrics report specified by the user is a non-standard metrics report. However it was old and well known in the art to allow a user of a system, which houses a database of information, to create a customized report that is designed to fit their individual needs. Therefore it would have been obvious to one of ordinary skill in the art to include this feature to Carlton-Foss so each individual user can view a summary of variables that are key to their evaluation of the auction process, as well as omit certain variables that they fell are negligible.

Re Claims 35-38: Carlton-Foss discloses the claimed computer readable medium but does not explicitly disclose wherein the computer readable medium is a logical node in a computer network receiving the contents, a computer readable disk, a data transmission medium transmitting a generated data signal containing the contents

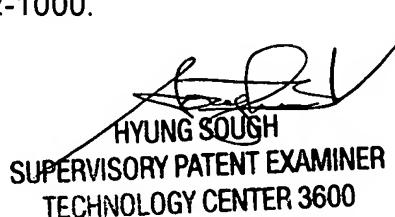
and a memory of a computer system. However these are all notoriously well known forms of computer readable medium. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Carlton-Foss to allow for any of the well-known computer readable mediums that the inventor desired. This allows for easy interfacing between the system and all customers.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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